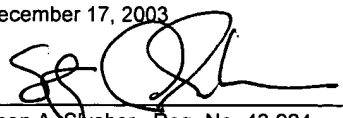


7648
PATENT APPLICATION

Hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on December 17, 2003


Stephen A. Clusher, Reg. No. 43,924

RECEIVED

DEC 31 2003

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/914,669
Applicant(s) : Diane E. Goade, et al.
Filed : January 25, 2002
Title : Herpes Simplex Virus Reactivation Model
TC/A.U. : 1648
Examiner : Zachariah Lucas

Docket No. : MC-158.USA
Confirmation No. : 9994

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

PROVISIONAL ELECTION WITH TRAVERSE

Sir:

In response to the Office Action dated November 17, 2003, the Applicants provisionally elect the claims of Group I, and respectfully traverse the restriction requirement as set out herein and requests that it be reconsidered. As noted below, it is suggested that Group I properly consists of claims 1 and 6-11.

The Examiner asserts the existence of four inventions: Group I, with claims 1 and 6-13, drawn to "methods of determining the effectiveness of a composition to inhibit HSV infection reactivation"; Group II, with claims 2, 3, 6, 8-10 and 14, drawn to "methods to determine the effectiveness of a composition to

inhibit HSV infection"; Group III with claims 4 and 6-13 drawn to "methods of determining the effective dose of a composition to inhibit HSV reactivation" and Group IV, with claims 5, 6, 8, 10, 11 and 15 drawn to "methods to determine the effectiveness of a composition as a UV protectant". It is noted that claims 12 and 13 depend from claim 4, and thus should not properly be included in Group I. Applicant provisionally elects the claims of Group I.

It is submitted that the inventions of Groups I, III and IV all involve a "single general inventive concept" under PCT Rule 13.1 because each has, under PCT Rule 13.2, the same or a corresponding special technical feature. Each of independent claims 1, 4 and 5 involve a herpes virus reactivation model, in which an abrasion is induced on the animal and a herpes simplex virus is introduced to the abrasion, "without having prior thereto exposed the animal to localized radiation." It is this aspect of the invention that constitutes a special technical feature. In the case of independent claims 1 and 4, the method further involves the administration of a "composition to inhibit herpes simplex virus infection reactivation" and thereafter exposing the area of reactivation to radiation. In the case of independent claim 5, a specific "composition to inhibit" is employed, i.e., a UV protectant. Independent claim 1 differs from 4 in that 1 is drawn to "determining the effectiveness" of a composition, while 4 involves the same methodology but specifically employing different doses to determine an effective dose. As noted, claim 5 differs in that the "composition" is specifically a UV protectant.

The Office Action asserts that the inventions "lack a common special technical feature because the common method, the making of a HSV reactivation model, is known in the art." An article by Norval et al. is cited for this proposition. It is submitted that Norval et al. does not disclose the special common technical feature, i.e., a primary infection specifically prior to exposure of the animal to localized radiation. Norval et al. specifically requires "u.v.-irradiation before the primary HSV infection..." in order to induce recrudescence in a "proportion of mice." Norval et al., page 2694, second full paragraph. As Norval et al.

explicitly states, that reference "describes a reproducible murine model of recrudescence which involves pre-exposure of animals to an external immunosuppressive signal [u.v.-irradiation] before infection with HSV." Page 2697, first full paragraph. The common special technical feature of each of claims 1, 4 and 5 requires that the animals are infected with herpes simplex virus "without having prior thereto exposed the animal to localized radiation." Norval et al., by requiring exposure to radiation prior to herpes simplex virus infection, actually teaches away from Applicants' invention. Thus properly applying the common technical feature of claims 1, 4 and 5, it is clear that this feature was not, on the basis of Norval et al., known in the art.

Additionally, Applicants note that Groups I, III and IV of necessity would require the same search (i.e., both Groups III and Group IV are essentially special cases of Group I), Applicants believe no additional search burden would be borne by the Examiner to concurrently examine Groups I, III and IV.

Applicants respectfully request that the restriction requirement be reconsidered and withdrawn, and that all the claims of the Application proceed to an examination upon the merits.

Should the Examiner have any comments, questions or suggestions relating to a speedy disposition of the application, the Examiner is invited to call the undersigned at (505) 998-6130.

Respectfully submitted,



Stephen A. Slusher, Reg. No. 43,924
Direct line (505) 998-6130

PEACOCK, MYERS & ADAMS, P.C.
Attorneys for Applicants
Post Office Box 26927
Albuquerque, New Mexico 87125-6927
Telephone: (505) 998-1500
Facsimile: (505) 243-2542